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10/777,717	02/12/2004	Christopher James Dawson	AUS920030842US1	5923

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EXAMINER

ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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02/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/777,717	Applicant(s) DAWSON ET AL.	
	Examiner WILLIAM J. ALLEN	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-12,14-24,26,27,29-34 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-12, 14-24, 26-27, 29-34, and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Prosecution History Summary

Claims 2, 4, 13, 25, 28, 35 have been canceled.

Claims 1, 3, 5-12, 14-24, 26-27, 29-34, and 36-41 are pending and treated as set forth below.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/18/07 has been entered.

Response to Arguments

Applicant's arguments filed 12/18/07 have been fully considered but they are not persuasive. Applicant contests that the combination of references fails to teach the aspect of a "read only file", however, the Examiner disagrees for at least the following:

First and foremost, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). To this accord the Examiner notes the following:

Albazz specifically teaches negotiating a contract over a network between a buyer and a seller and once the contract is approved by the negotiating parties utilizing digital signature technology, the contract elements are linked, sealed, and saved at the marketplace (see at least: 0088, 0097). Of important note is the locking of static elements of the contract, which prevents further modification of those terms (see at least: 0088). Though Albazz teaches where static elements of the contract are locked and the contract itself is stored, Albazz lacks an explicit teaching of *saving the file as a read only token*. This deficiency is remedied, though, by Conant, Which teaches generating a read-only version of a contract on which a watermark can be placed on the read-only file upon execution of a contract by both parties using an electronic signature (see at least: 0032). In this regard, it is clear that the combination of references as applied teaches the noted limitation.

Furthermore, with regards to the newly presented limitations, the Examiner asserts that the combination of Albazz, Conant, and Conklin teaches the claims as amended. For instance,

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Conant teaches *using a single computer connected to an ecommerce website* (see at least: Fig. 1 (#140), 0018-0019). Similarly, Conklin shows such features in Fig. 1b of the issued patent.

Additionally, Albazz teaches *presenting the plurality of agreement terms for the sale of the good to the buyer and seller* (see at least: 0096, Fig. 7-8), *determining whether the buyer and the seller agree with the plurality of agreement terms* (see at least: 0097, Fig. 7 (note “approve contract”)), and *responsive to the determination that the buyer and seller agree with the plurality of agreement terms, adding a buyer digital signature and a seller digital signature to the file* (see at least: 0097, Fig. 7-8).

In accordance with the above, claims 1, 3, 5-12, 14-24, 26-27, 29-34, and 36-41 are rejected as set forth below.

Regarding the rejection under 35 USC 101, despite Applicant’s amendment, the Examiner notes that the program product, which is stored on a computer readable medium and contains a plurality of agreement terms still represents non functional descriptive material (i.e. the program product is merely a data structure/data per se stored on some medium but lacking any imparted functionality). Simply renaming the shopping token a “program product” does not suffice to remove the rejection under 35 USC 101. For instance, as was the case with the shopping token, the newly claimed program product is merely a product made by a computer implemented steps (i.e. a product by process). The claim is thereby directed to the product (the program product itself) because product by process claims are limited to the structure implied by the steps of the claim and not the steps themselves.

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 26-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally

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interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Independent claim 26 fails to show imparted functionality and is merely drawn to a data structure (i.e. a *shopping token* containing information). The Examiner notes that the program product, which is stored on a computer readable medium and contains a plurality of agreement terms represents non functional descriptive material (i.e. the program product is merely a data structure/data per se stored on some medium but lacking any imparted functionality). Simply renaming the shopping token a “program product” does not suffice to remove the rejection under 35 USC 101. For instance, as was the case with the shopping token, the newly claimed program product is merely a product made by a computer implemented steps (i.e. a product by process). The claim is thereby directed to the product (the program product itself) because product by process claims are limited to the structure implied by the steps of the claim and not the steps themselves.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 1, 3, 5-12, and 37-41 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

The Examiner notes that claims 1 and 37 recite “wherein data in the shopping token cannot be *cut* and pasted”, however, this feature is not supported by the original disclosure.

According to the abstract and paragraph 0014, Applicant's disclosure is supportive of preventing data from *copy* and paste rather than *cut* and past.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3, 5-12, and 26-27, 29-34, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, claim 1 is indefinite for at least the following reasons: In lines 6-7 of the claim, claim 1 recites “using a single computer connected to an ecommerce website...”. This limitation is ambiguous as it is unclear as to whether a single computer is used by both the buyer and seller to access the website, or conversely, if a buyer and seller at separate computers access the website through a single computer as in a computer server. Figures 1 and 3B of Applicant’s specification, as well as paragraphs 0029 and 0035 seem to support the aspect of a third party computer or server being accessed through individual buyer and seller computers. For purposes of Examination, the Examiner will interpret the claims to be drawn to a third party server/computer accessed through individual buyer and seller computers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-9, 14-21, 26-33, and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albazz et al. (US 20020042872) in view of Conant et al. (US 20020129056) in further view of Conklin et al. (US 6141653).

Regarding claim 1, Albazz teaches a system and method for automating contract negotiations and facilitating contractual activities pursuant to the agreed upon contract (see at least: abstract). Albazz further teaches creating a contract between a buyer and a seller in an online transaction by means of a shopping token that contains a plurality of agreement terms (see at least: abstract, 0016, 0085-0086). More specifically, Albazz teaches *presenting the plurality of agreement terms for the sale of the good to the buyer and seller* (see at least: 0096, Fig. 7-8), *determining whether the buyer and the seller agree with the plurality of agreement terms* (see at least: abstract lines 10-12, 0015, 0097, Fig. 7 (note “approve contract”)), and *responsive to the determination that the buyer and seller agree with the plurality of agreement terms, adding a buyer digital signature and a seller digital signature to the file* (see at least: 0025, 0043, 0097, Fig. 7-8).

Additionally, Albazz creates a contract profile (analogous to the *created file*) with the resulting agreed upon contract “locked” using digital signatures (see at least: 0025 [note the final

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2 lines], 0097). Once approved by the negotiating parties and signed utilizing digital signature technology, the contract elements are linked, sealed, and saved (i.e. *responsive to the addition of digital signatures, saving the file as the shopping token*) at the seller's e-commerce site or marketplace (see at least: 0088, 0097). [Note: The saved and locked contract that is executable constitutes a *shopping token*]. Albazz also teaches *wherein data in the shopping token cannot be cut and pasted from the shopping token* by locking the contract to prevent accidental or deliberate changes to the contract elements (i.e. *cut and pasting* [note applicant's specification, Paragraph 14]) (see at least: 0016, 0086). The contract *can be stored on a buyer computer, a seller computer, or a third party computer* (see at least: 0088), registered as a signed contract (see at least: 0097), and referenced whenever a buyer-seller transaction is initiated. [The Examiner notes that because there are multiple contracts (see at least: 0011, 0106), and because the contracts are stored, registered, and referenced for use in buyer-seller transactions, the different contracts are thereby *indexed so that they can be distinguished* from one another].

Though Albazz teaches where static elements of the contract are locked and the contract itself is stored (see at least: 0088), Albazz does not specifically teach *saving the file as a read only token*, nor does Albazz teach *using a single computer connected to an ecommerce website*.

In the same field of endeavor, Conant teaches a method and apparatus for negotiating the content of a documents via an electronic exchange (see at least: abstract). More specifically, Conant teaches where, upon execution of a contract by both parties using an electronic signature, generating a read-only version of the contract upon which a watermark can be placed on the

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read-only file (see at least: 0032). Thereby, Conant teaches, in response to applying a digital signature, *saving the file as a read only token*. In addition, Conant teaches *using a single computer connected to an ecommerce website* (see at least: Fig. 1 (#140), 0018-0019). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Albazz to have included *saving the file as a read only token* as taught by Conant in order to provide a negotiating tool providing improved document control while facilitating proper interpretation of the document upon completion (see at least: Conant, 0007).

Additionally, Albazz teaches all of the above but does not expressly teach the creation and use of files in *XML*, though Albazz does show compliance with XML and the creation of a contract profile (i.e. *file*) for an associated contract that is modifiable until approved and finalized (see at least: 0046, 0016, 0086).

Also, in the field of electronic negotiations, Conklin teaches a multivariate negotiation engine for iterative bargaining (see at least: abstract). Conklin provides a system operated at the provider's Internet site, the system maintaining internal databases that contain the history of all transaction, and allows buyers and sellers to return to the system to resume negotiations (see at least: abstract, col. 13 lines 61-63, col. 19 lines 29-38, col. 21 lines 39-45, col. 24 lines 1-41). Conklin further teaches where information transmitted through the multivariate negotiation system may be in a variety of formats including HTML, Java, Java Scripting, or XML (see at least: col. 20 lines 45-49, col. 21 lines 32-36, col. 28 lines 23-29).

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It would have been obvious to one of ordinary skill in the art at the time of invention to have included the creation and use of files in *XML* as taught by Conklin in order to provide a negotiation engine for iterative bargaining that brings together participants with similar interests and further enables the creation of knowledgeable communities of commerce (see at least: Conklin, abstract (lines 1-4), col. 13 lines 58-60). Additionally, the Examiner points out that Applicant has failed to show the criticality of using XML as opposed to other file formats and further notes that the incorporation of such a feature is no more than the predictable use of prior art elements according to their established function.

Lastly, in addition to the above, Albazz, Conant, and Conklin collectively teach various types of contract elements such as price (Conant, abstract) deliver/shipping methods and payment methods (Albazz, 0008), and quantity (Conant, abstract), the Examiner asserts that the specific types of contract elements do not move to distinguish the claimed invention. More specifically, to have included such element types as those claimed would have been obvious because the incorporation of such features is recognized as part of the ordinary capabilities of one skilled in the art and further because the type of element in the contract does not materially impact the invention in such a way as to patentably distinguish over the prior art.

Regarding claims 3-7, Albazz in view of Conant in view of Conklin further teaches:

(3) *adding a seller's personal information, a buyer's personal information, information regarding the good, and a plurality of terms to the file* (see at least: Albazz, 0043-0044); The Examiner notes that main information elements in the business contract include a seller profile (*seller personal information*), a buyer profile (*buyer personal information*), traded goods and prices (*information regarding a good*), and terms and conditions.

(5) *responsive to the determination that the buyer and seller do not agree with the terms, means for accepting a modification to the terms* (see at least: Albazz, abstract, 0039, Fig. 7 and 9).

(6) *wherein the shopping token is created after the buyer is aware of the delivery date* (see at least: Albazz, 0043). The Examiner notes that the main elements further include delivery mechanisms and schedules (i.e. *deliver date*). Furthermore, these terms are agreed upon (and thereby the buyer is aware of the delivery schedule) before the contract is saved and stored (i.e. *the shopping token is created*).

(7) *wherein the shopping token may be configured so that the shopping token is not modifiable by the buyer or seller* (see at least: 0016, 0025, 0097).

Regarding claims 8-9, though Albazz teaches storing the contract as an enforceable contract with the seller (see at least: 0088), Albazz does not expressly teach *wherein the shopping token is stored on a third party computer and is accessible by the buyer and the seller* nor does Albazz teach where the terms included in the token contains *warranty information*. Conklin teaches a negotiations system operated at a system provider's (third party) site at which buyers and sellers gather to perform electronic negotiations. Both changes to the negotiated terms and accepted/finalized terms are stored in the system. Thereby, Conklin teaches *wherein the shopping token is stored on a third party computer and is accessible by the buyer and the seller* (see at least: abstract, col. 24 lines 1-41, col. 25 lines 12-20). Conklin also teaches negotiating terms including warranty information for a good (see at least: Fig. 28, col. 1 lines 41-47, col. 30 line 66-col. 31 line 11). It would have been obvious to one of ordinary skill in the art at the time of invention to have included *wherein the shopping token is stored on a third party computer and is accessible by the buyer and the seller* and to have included terms regarding *warranty information* as taught by Conklin in order to provide a negotiation engine for iterative bargaining that brings together participants with similar interests and further enables the creation of knowledgeable communities of commerce (see at least: Conklin, abstract (lines 1-4), col. 13 lines 58-60).

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Regarding claims 14-21 and 26-33, claims 14-21 and 26-33 closely parallel claims 1, 3, and 5-9 and are thereby rejected for at least the reasons above with regards to claims 1, 3, and 5-9.

Regarding claims 37-38, claims 37-38 closely parallel claims 1, 3, and 5-9 and are thereby rejected for at least the reasons above with regards to claims 1, 3, and 5-9.

3. Claims 10-12, 22-24, 34-36, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albazz in view of Conant in view of Conklin as applied to claims 1, 3-9, 14-21, 26-33, and 37-38, and in further view of Moss et al. (US 20050160014).

Regarding claims 10-12, 22-24, 34, 36, and 39-41, Albazz in view of Conant in view of Conklin teaches all of the above as noted but does not expressly teach *wherein the shopping token is used for price protection and price promotion for the good, and to analyze a seller's history by a buyer*. Moss teaches *wherein the shopping token is used for price protection and price promotion for the good* (see at least: 0007, 0032, 0047, Fig. 30-31). Note the price matching includes the retailer's own advertised prices (Fig. 31). Additionally, Moss teaches a *buyer analyzing the history of a seller* by providing a buyer with the ability to view transactions within the last 3 months or since joining the service ("historical price match transactions") to determine the outcome and savings received from each transaction (see at least: 0082, Fig. 4). The Examiner notes that each transaction shows an associated seller and the amount saved by using that seller, thereby providing a *seller history* for the buyer. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Albazz in view of Conant in view of Conklin to have included *wherein the shopping token is used for price protection and price promotion for the good* as taught by Moss in order to provide a service that helps users find and compare the best prices and promotions available (see at least: Moss, 0006).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 4981370 A discloses a document authentication apparatus
- US 5191613 A discloses a knowledge based system for document authentication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM J. ALLEN whose telephone number is (571)272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/William J Allen/
Examiner, Art Unit 3625

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Primary Examiner, Art Unit 3625